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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,798	06/16/2000	William J. Brosnan	IGTIP021/P000239-001	3320
79646                      7590                      09/16/2009 Weaver Austin Villeneuve & Sampson LLP - IGT Attn: IGT P.O. Box 70250 Oakland, CA 94612-0250				
EXAMINER				
MCCULLOCH JR, WILLIAM H				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
09/16/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/595,798

**Applicant(s)**

BROSNAN, WILLIAM J.

**Examiner**

William H. McCulloch

**Art Unit**

3714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27, 28 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27, 28 and 38-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 3/13/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below. Claims 27-28 and 38-56 are pending in the application.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 27, 28, 38-42, 44-53, and 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,913,531 to Yoseloff (hereinafter "Yoseloff").

Regarding claims 27 and 46, Yoseloff teaches a method for providing game downloading in a gaming system including the following elements (in the context of claim 27):

- (i) a first housing (e.g. a personal computer in 11:10-13 or apparatus in 12:52-13:11);
- (ii) a first master gaming controller coupled to the housing designed or configured to control a first game selected from a list of games displayed on the first gaming machine (processor or microprocessor in 10:43-47, monitor or display device in 11:31-36);
- (iii) one or more displays coupled to the first housing for displaying the first game controlled by the first master gaming controller or the list of games (monitor or display device in 11:31-36 or 12:52-13:11);
- (iv) one or more first input devices coupled to the housing for accepting cash or indicia of credit wherein the cash or indicia of credit are for making wagers on the first game played on the first gaming machine (e.g. bet one credit button 10, currency or coin slot/acceptor 22, maximum bet button 26 in 12:60-64, or input devices in 11:22-28);
- (v) a first communication interface connected to a network for communication with at least a second gaming machine (network interfaces in 11:61-12:11);
- (vi) a first memory for storing executable coding instructions downloaded from the second gaming machine (e.g. drives and RAM storing downloadable

program modules in at least 11:5-17; program modules are described in at least 10:20-30);

- (vii) a first output device coupled to the first housing for outputting the cash or the indicia of credit (payout indicated in payout window, see at least 13:56-59; see also 7:57-61 and 8:10-20).

Yoseloff teaches that a second gaming machine is substantially the same or exactly the same as the first device in 11:44-46. The second machine in one embodiment is described as a "peer" device in 11:43. Additionally, both devices include an award mechanism to pay winnings to a player (see at least 7:57-61, 8:10-20, 13:56-59, and pay tables in columns 13-14). Furthermore, Yoseloff teaches that the game method may be implemented on numerous types of gaming devices, including those associated with a casino, having a network connection, and may include a bank of video gaming equipment, such as the type associated with a coordinated jackpot function (see at least 9:47-10:18 and 11:40-13:59).

The aforementioned program modules enable the gaming machine to load and execute a particular game, as shown in 10:20-42. The gaming devices would not be able to play a particular game unless they have available the executable coding instructions (or program) to process the corresponding information. Furthermore, Yoseloff teaches that the gaming devices may obtain the program modules by downloading them from a network, such as the Internet, in 11:5-17. Yoseloff teaches that downloading may be associated with a manual operation performed by a human operator (see at least 9:51-59). The recitation of "downloading" one or more program

modules of a collection of available modules necessitates that a program module is selected for transfer by a user, at which point a signal indicating the selection is sent to a second gaming device to begin the information transfer (see *Id.*) Yoseloff does not use the term "list" of programs, but allows for multiple program modules to be downloaded under the control of the player. Therefore a list of program modules is inherently present in Yoseloff's system in order to allow the user of Yoseloff's gaming device to select a program module for download. The examiner notes that the functionality of Yoseloff's system with regard to downloading program modules under the player's control could not function without a list from which the player chooses one or more modules to download.

Yoseloff teaches a well known video gaming apparatus or system, whereby wagers are placed through "coins, currency, crediting, debiting or the like" (see 12:52-54). Yoseloff teaches an additional "exemplary" embodiment using a conventional personal computer or client computer (see at least 10:43-12:45). While Yoseloff does not explicitly state that the embodiments are combined into one embodiment, Yoseloff states that

"[T]he programs, processes, methods, etc. described herein are not related or limited to any particular computer, software, operating system or apparatus, nor are they related or limited to any particular communication architecture. Rather, various types of general purpose machines may be used with program modules constructed in accordance with the teachings described herein. Similarly, it may prove advantageous to construct a specialized apparatus to perform the method

steps described herein by way of dedicated computer systems in a specific network architecture with hard-wired logic or programs stored in nonvolatile memory, such as read only memory. Additionally, the methods described herein may be practiced on a universal gaming system apparatus such as that described in copending U.S. patent application U.S. Ser. No. 09/405,921 filed on Sept. 24, 1999 titled "Gaming Apparatus for Wagering with Universal Computer Motherboard", which Application is incorporated herein by reference for its disclosure of such architecture, harness, I/O systems, hardware and software." (9:66-10:18).

In view of the above citation, it is clear that Yoseloff views the particular apparatus used to carry out functions of the game to be of no special significance. Indeed, Yoseloff makes clear that one of ordinary skill in the art could choose any combination of the computers, software, operating systems or apparatuses. Therefore, the claimed invention would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." See *KSR International Co. v. Teleflex Inc.*

Furthermore, the '921 application (US 2001/0053712) which is incorporated by reference discloses a universal computerized controller that employs a "standard IBM Personal Computer-compatible (PC compatible) computer" (par. 22) in combination with "devices such as token, money, or credit receiving devices and return devices will allow

a user to establish credited value to be wagered in the course of the game and to cash out when play is completed" (par. 17). The universal computerized controller may further include a commercially available motherboard, such as a '386 PC' motherboard including an Intel Pentium class processor, and a network connection (see pars. 47-48). This is yet another embodiment that reads on the claimed invention by incorporating standard casino wagering device technology with standard personal computer technology.

Regarding claims 28, 40, 47, and 48-49, Yoseloff teaches games including slot games (see at least 8:10-20) and card games, such as known variations of poker (see at least 5:25-41). As described above, the first and second gaming machines may be substantially identical. Since the program code transferred between the machines becomes resident on both machines, the second gaming machine has the same games available for play as the first.

Regarding claims 38 and 50, the network embodiments are wired networks (see at least 11:61-12:11).

Claims 39 and 51 are directed toward a network comprising one or more wired or wireless connections, wherein one of the wired connections is a fiber optic connection. Yoseloff teaches transmitting program data over the global Internet, which is known to use fiber optic communication systems in network "backbones". Therefore, at least one of the wired connections in Yoseloff is a fiber optic connection.

Regarding claims 41 and 52, Yoseloff teaches embodiments of a bonus game (jackpot) or a progressive game (coordinated jackpot) in at least 11:53-60.



Regarding claims 42 and 53, as described in 10:27-30, Yoseloff teaches that program modules include code, applets, routines, programs, components, objects, and data structures, which anticipate the claimed software settings for the executable coding instructions.

Regarding claims 44 and 55, as described above, Yoseloff teaches that the program modules may contain various code segments that carry out the basic functions of the gaming system, indicating that one or more of the above are analogous to hardware settings. Further support comes from Yoseloff in 12:12-15, which states that the game control module within the video gaming apparatus is embodied in software, hardware, or a combination of both, indicating that in some embodiments the software settings and hardware settings are one in the same.

Regarding claims 45 and 56, the term "casino area network" is interpreted herein as a local or wide area network embodied in one or more casinos. A similar interpretation was made in a previous final rejection. Yoseloff teaches that the networking environments are commonplace in casinos (11:61-65). As described above, the gaming machines may participate in bonus or progressive play.

4. Claims 43 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff in view of U.S. 6,306,035 to Kelly et al. (hereinafter "Kelly").

Yoseloff teaches a gaming system substantially as described above. Yoseloff further teaches that gaming machines may be spread across multiple gaming jurisdictions (11:53-60). Yoseloff lacks in specifically disclosing that the software

settings transmitted from one gaming machine to another relate to gaming jurisdictions. In an analogous disclosure, Kelly teaches identifying gaming machines in particular gaming jurisdictions and altering game settings according to the individual jurisdictions (see at least 12:56-13:22). Kelly teaches that such individual jurisdictional settings would allow the invention to restrict access to certain games in accordance with local gambling laws. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include jurisdictional data in the program modules of Yoseloff in order to operate within local laws, as favorably taught by Kelly.

#### ***Response to Arguments***

5. Applicant's arguments with respect to the claims have been considered but are fully addressed by, or moot in view of, the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./  
Examiner, Art Unit 3714  
9/10/2009

/Peter D. Vo/  
Supervisory Patent Examiner, Art Unit 3714